



10-15-04

JFW AF/3671

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Jack O. CARTNER

Serial No.: 09/587,197

Group Art Unit: 3671

Filed: June 5, 2000

Examiner: Lisa Klaus

For: **MOWER HEAD WITH MOVABLE GUARD**

Attorney Docket No.: CRTZ 2 00017-1

MAIL STOP Appeals Brief -- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**TRANSMITTAL OF BRIEF OF APPELLANT**

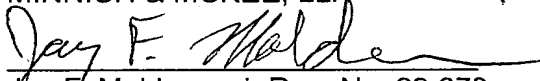
Dear Sir:

In connection with the above-entitled case, attached is a check for payment of Patent and Trademark Office fees in the amount and for the purpose below indicated:

Filing a Brief in Support
of an Appeal (in triplicate)**\$170.00**

The Commissioner is hereby authorized to charge all fees which may be required or credit any overpayment to Deposit Account No. 06-0308.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & MCKEE, LLP
Jay F. Moldovanyi, Reg. No. 29,678
James E. Scarbrough, Reg. No. 47,065
1100 Superior Avenue, Seventh Floor
Cleveland, Ohio 44114-2518
(216) 861-5582

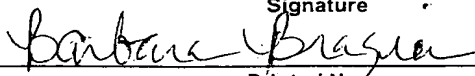
N:\CRTZ\200017\1A\bjb0002396V001.doc

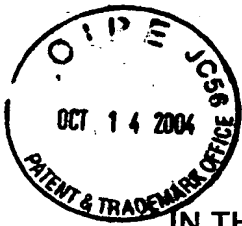
Certificate of Mailing

Under 37 C.F.R. § 1.8, I certify that this **Appeal Brief** (in triplicate) is being

- ☐ deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP APPEAL BRIEF - PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
- ☐ transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.
- ☒ deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP APPEAL BRIEF -- PATENTS, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Express Mail Label No.:
EV 494997518 US
Date
October 14, 2004

Signature

Printed Name
Barbara Brazier



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S) : Jack O. Cartner
TITLE : MOWER HEAD WITH MOVABLE
GUARD
APPLICATION NO. : 09/587,197
FILED : June 5, 2000
CONFIRMATION NO. : 8327
EXAMINER : M. C. Petravick
ART UNIT : 3671
LAST OFFICE ACTION : April 6, 2004
ATTORNEY DOCKET NO. : CRTZ 2 00017-1
Cleveland, Ohio 44114-2518

RULE 37 C.F.R. §1.192 APPELLANT'S BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is in furtherance of the Notice of Appeal that was filed in this case on May 17, 2004.

The fees required under 37 C.F.R. §1.17 and any required petition for extension of time for filing this Brief and fees therefore are dealt with in the accompanying Transmittal of Appeal Brief.

Appellant files herewith an Appeal Brief in connection with the above-identified application wherein claims 10, 11, 13, 17, 19, 39, 40 and 65-73 were finally rejected in the final Office Action mailed April 6, 2004. What follows is Appellant's Appeal Brief (submitted in triplicate) in accordance with 37 C.F.R. §1.192(a).

I. Real Party in Interest (37 C.F.R. §1.192(c)(1))

The real party in interest in the subject Appeal is the Inventor named in the caption of this Brief (Jack O. Cartner). Mr. Cartner is the owner and president of MoTrim Inc. of Cambridge, Ohio.

II. Related Appeals and Interferences (37 C.F.R. §1.192(c)(2))

There are no other applications involved in an appeal or interference before the U.S. Patent and Trademark Office from which the present application bases its priority, or any case which bases its priority upon the present application that will directly affect or will be directly affected by, or will have a bearing on the Board's decision in this Appeal.

III. Status of Claims (37 C.F.R. §1.192(c)(3))

The status of the claims set forth after the final Office Action mailed April 6, 2004 was and is as follows: allowed claims: **none**, rejected claims: **10, 11, 13, 17, 19, 39, 40, 65-73**. The present Appeal is directed specifically to independent claims 65, 68, 72, and 73 and dependent claims 10, 17 and 19.

IV. Status of the Amendments (37 C.F.R. §1.192(c)(4))

No amendments to the claims were made after the final Office Action of April 6, 2004.

V. Summary of the Invention (37 C.F.R. §1.192(c)(5))

The present application is directed to a mower head having a polygonal deck with a plurality of sides. One side is positioned at an acute angle with respect to other sides, which are oriented approximately normal to each other. A cutting blade is rotatably mounted to the deck on an axis which extends through the deck. The deck is disposed above and generally parallel to the blade.

A guard assembly comprises a guard mounted to the deck via a hinge and an actuating member mounted to the deck and to the guard. The guard is pivotally attached to the deck along two adjacent sides of the deck. A flap which depends from the guard extends in front of the blade. (See FIGURES 3A and 3B and pages 9-10 of specification).

In all the embodiments, the guard is located at a single corner of the deck. That corner is located outboard of the boom on which the mower head is mounted, see FIGURE 6.

The guard has a top surface which, in the first embodiment, is located in the same plane as the top surface of the deck. In one embodiment, the guard includes a first wall which comprises an approximately straight edge and a second wall which comprises a plurality of angled sections.

In operation, the guard is lifted out of the cutting path of the mower head through a pivoting motion along the hinge by the actuating member. The guard is lifted at an angle with respect to the path of travel of the deck and is pulled toward the center of the deck (see FIGURE 6, pg. 10 of specification). The blade then extends beyond the side walls of the deck through an opening and is able to cut larger vegetation, such as trees, shrubs and the like.

A second embodiment is directed to a mower head with a top surface of a guard being located in a different plane from a top surface of a deck. A side of the deck adjacent the guard can vary in shape with respect to the guard. Thus, the side can have an extension protruding under the guard and over a blade, thereby covering more of the blade when the guard is in the open position. (See FIGURES 4A and 4B, pages 10 and 11 of the specification).

A third embodiment is directed to a mower head having a deck with a plurality of angled sections. A guard also has a plurality of angled sections which matingly interconnect with the angled sections of the deck side. The angled sections of the deck side protrude further over the top of the blade. This provides additional shielding of the blade, as well as preventing debris from flying up from the blade during cutting.

VI. Issues (37 C.F.R. §1.192(c)(6))

Whether claim 68 is indefinite under 35 U.S.C. § 112.

Whether claims 17, 65, 68 and 73 are unpatentable under 35 U.S.C. §102 over U.S. Patent No. 3,496,707 (Kobey).

Whether claims 10 and 19 are unpatentable (presumably) under 35 U.S.C. § 103 over Kobey in view of U.S. Patent No. 5,657,620 (Thagard).

Whether claim 72 is unpatentable under 35 U.S.C. §103(a) over Kobey in view of the MoTrim Boom Mower brochure (MoTrim).

VII. Grouping of Claims (37 C.F.R. §1.192(c)(7))

The claims at issue do not stand or fall together. Specifically, claims 10, 17, 19, 65, 68, 72 and 73 each recite separately patentable subject matter.

Claim 65 recites a mower head having a deck with at least three sides, and at least one cutting blade rotatably mounted to the deck on an axis extending through the deck. The deck is disposed above and generally parallel to the blade. A guard assembly has a hinge extending between and mounted to two of at least three sides of the deck at an angle with respect to two of the at least three sides. A guard is pivotally attached to the deck via the hinge, wherein a horizontal plane of the guard is parallel to, and spaced from, a horizontal plane of the deck in one orientation of the guard.

Claim 68 recites a mower head having a deck with at least four sides and four corners, and three side walls, one depending from each of three of the at least four sides, wherein two of the three side walls are rigid. At least one cutting blade is rotatably mounted to the deck on an axis extending through the deck. The deck is disposed above and generally parallel to the blade. A guard assembly has a hinge mounted to and extending at an angle in relation to two adjacent ones of the at least four sides of the deck. A guard is pivotally attached to the deck via the hinge. The guard has a plurality of discretely angled sections which together form a single corner of the deck.

Claim 72 is directed to a mower head having a deck with at least four sides including a front side and a boom arm to which the deck is mounted. The boom arm is positioned adjacent a first side edge of the mower head. A guard assembly has a hinge extending at an angle between the front side and an adjacent one of the sides of the deck. A guard is pivotally attached to the deck via the hinge. The guard is positioned adjacent a second side edge of the mower head which is located opposite the first side edge.

Claim 73 recites a mower head having a deck with four sides. At least one cutting blade is rotatably mounted to the deck on an axis extending through the deck. The deck is disposed above and generally parallel to the blade. A guard assembly has a guard pivotally attached to the deck via a hinge which extends between two adjacent ones of the four sides of the deck such that the guard is positioned in a first corner of the deck. The guard is selectively pivotable to a position above a plane of the deck. The deck has a second corner, located adjacent the guard assembly, which has two side walls that are rigid and non-moving. A first side of the deck includes both the first and second corners.

Claim 10 depends from claim 65 and adds the limitation that the actuating member comprises a hydraulic cylinder and a piston. The cylinder includes a chamber surrounding the piston.

Claim 17 depends from claim 65 and adds the limitation that one of the three sides further has an extension which protrudes under the guard.

Claim 19 depends from claim 68 and adds the limitation that the actuating member comprises a hydraulic cylinder and piston assembly.

VIII. Arguments (37 C.F.R. §1.192(c)(8))

The Examiner rejected claim 68 as being indefinite under 35 U.S.C. § 112, second paragraph. The Examiner rejected claims 17, 65, 68 and 73 under 35 U.S.C. § 102(b) as being anticipated by Kobey. Claims 10, 19, 39, 40, 67, 70 and 71 were rejected under 35 U.S.C. § 103(a) as being unpatentable, presumably, over Kobey in view of Thagard. Claim 72 was rejected under 35 U.S.C. § 103(a) as being

unpatentable over Kobey in view of the MoTrim Boom Mower Brochure. The appellant respectfully disagrees.

1. Summary of Arguments

None of the applied three references, Kobey, Thagard or MoTrim, in any combination, renders unpatentable the subject matter recited in claims 10, 11, 13, 17, 19, 39, 40 and 65-73. Furthermore, claim 68 is not indefinite under 35 U.S.C. § 112. Details of Appellant's arguments are provided in more detail below.

2. Appellant's Arguments Re: Claim 65

Claim 65 patentably defines over Kobey, since Kobey does not show a guard with a horizontal plane that is parallel to and spaced from the horizontal plane of the deck in one orientation of the guard. Rather, the horizontal plane of the guard of Kobey is co-planar with the horizontal plane of the deck (see Fig. 3 of Kobey). The Examiner acknowledged this in the rejection of claim 61 (now canceled) in the Office Action dated November 6, 2003, noting that the horizontal plane of Kobey's deck is co-planar with a horizontal plane of the guard.

Notwithstanding this, the Examiner now contends that the disclosure in Kobey is so malleable as to allow this reference to be used to show the polar opposite of the subject matter recited in canceled claim 61, namely a horizontal plane of the deck spaced from a horizontal plane of the guard. The Office Action contends that a plane formed by the top surface of the mower deck and a plane formed by the bottom surface of the guard are parallel to each other and spaced from each other by the width of either the mower deck or guard. The Examiner stated that the plane of the deck and guard formed by the top surfaces is co-planar and the difference is which planes are considered.

Frankly, this contention is raising form over substance. A reading of the plain language of claim 65 would lead one to conclude that the horizontal planes of the guard and deck mentioned in the claim refer to planes extending midway through the thickness of these relatively thin metal members. The guard is clearly spaced from the deck in Fig. 4b of the present invention. For contrast, Kobey shows the guard

and deck as being clearly aligned in the same plane. Moreover, the Examiner should not be allowed to make contradictory interpretations of the teachings of Kobey to reject two clearly different claims, namely, claim 61 (which has been canceled without prejudice) and claim 65.

Accordingly, claim 65 and claims 11, 13, 39, 66, and 67 dependent therefrom are in condition for allowance.

3. Appellant's Arguments Re: Claim 10

Claim 10 patentably defines over Thagard and Kobey since neither Kobey nor Thagard, et al. show a hydraulic cylinder with a piston on a deck which deck has a horizontal plane spaced from a horizontal plane of a guard. It simply would not be obvious to add a hydraulic cylinder with a piston to Kobey, which teaches a push lawnmower for home use, not a mower for commercial use.

In rejecting claim 10 as being unpatentable over Kobey in view of Thagard, the Examiner failed to show any motivation, suggestion, or teaching of the desirability for combining the inventions of Kobey and Thagard. The teachings of Kobey and Thagard can be combined only if there is some suggestion or incentive in one of the references, or the general state of the art, to do so. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). The Examiner, on the other hand, used impermissible hindsight in combining the push mower of Kobey with the commercial mower attached to a tractor and powered by a power take-off 131 from the tractor (see col. 7 lines 27-29 of Thagard). The Examiner is not allowed to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. *Id* F.3d at 1953 and USPQ2d at 1457.

"Obviousness cannot be predicated on what is unknown. *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 339, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989)." *Id* F.3d at 1534 and USPQ2d at 1957.

One of ordinary skill in the art would not be motivated to combine the teachings of Kobey with the teachings of Thagard because, firstly, the mowers of Kobey and Thagard are different types of mowers, one being a household push mower and one being a commercial grade tractor pulled mower. One would not be motivated to replace the handle 54 and cable 52 of Kobey with the hydraulic actuator or cylinder 182, 382 of Thagard in Kobey's household push mower. There is simply no need for a hydraulic circuit in the Kobey mower, and no place on the Kobey housing 36 for all the needed elements of such a hydraulic circuit, such as a hydraulic pump and a hydraulic fluid reservoir, in addition to the hydraulic cylinder for actuating the guard. Moreover, what would be the power source to drive such a hydraulic pump? The Kobey lawn mower engine 18 certainly could not do the job. The essence of hindsight is to piece together the disclosures of various prior art references without providing evidence of a suggestion, teaching or motivation to do so. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614.

In applicant's view, Kobey teaches away from its combination with Thagard. In other words, the mowers shown in Kobey and Thagard are so different that they cannot be combined without destroying the function of one or the other. Therefore, Kobey teaches away from the design shown in Thagard, thereby not providing any motivation to combine the aforementioned teachings. *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

As the Federal Circuit observes in *Tec Air*:

"There is no suggestion to combine ... if a reference teaches away from its combination with another source ... 'A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant ... [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.' *In re Gurley* ... (Fed. Cir. 1994)." *Id.* F.3d at 1360 and USPQ2nd at 1298.

Further, claim 10 is patentable over Kobey and Thagard for the reasons discussed above for claim 65, since Thagard does not disclose the features missing from Kobey.

4. Appellant's Arguments Re: Claim 17

Claim 17 patentably defines over Kobey, since Kobey does not teach one of three sides having an extension which protrudes under the guard. Referring to Figure 4A of the present specification, an extension 154 of the deck protrudes under the guard 152 and over blade 70. Kobey simply does not have any extension protruding under the guard. Further, claim 17 is also patentable over Kobey for the reasons outlined for claim 65, since Kobey does not disclose the features in claim 65.

5. Appellant's Arguments Re: Claim 68

Claim 68 was deemed by the Examiner to be indefinite under 35 U.S.C. § 112, second paragraph. Claim 68 was amended to add the limitation that the guard includes a plurality of discretely angled sections which angled sections together form a single corner of the deck. The Examiner stated that in the body of the claim, the guard is not listed as part of the deck but merely as part of the mower deck. Further, the deck is recited as having four corners and the guard as being attached to two of the four sides of the deck. The Examiner stated that the added limitation renders the claim indefinite since it is unclear whether the deck and guard are separate parts attached to each other or the deck comprises the guard.

Claim 68 recites that a plurality of discretely angled sections form a single corner of the deck. In the embodiment of Figure 3A of the present specification, there are a number of discretely angled sections 124-136. These form one corner of the mower. The deck and guard are separate parts attached to each other. When so attached, the guard comprises a single corner of the deck.

The guard basically extends over an angled edge of the deck and forms one of the corners of the mower. The guard, along with the other three corners of the

deck, form the four corners of the mower. Thus, claim 68 is not indefinite under 35 U.S.C. § 112.

Claim 68 was deemed by the Examiner to recite that the deck has four sides and four corners, but does not say that the corners have to be right angles. The deck of Kobey was considered by the Examiner to include four corners as seen in Figure 2. The Examiner asserted that the claim does not limit the number of angled sections to be more than 2 nor does it limit the angle to not 90 degrees.

Claim 68 recites that a plurality of discretely angled sections form a single corner of the deck. In the embodiment of Figure 3A of the present specification, there are a number of discretely angled sections 124-136. These form one corner of the mower. In contrast, in Kobey (Fig. 2) the discretely angled sections form the front wall and parts of two adjacent side walls, not one corner. "Corner" and "single" are simple terms for structure not shown in Kobey since Kobey simply does not disclose a guard having a plurality of discretely angled sections which form a single corner of a deck.

Moreover, claims 40 and 69-71 dependent on claim 68 are also in condition for allowance.

6. Appellant's Arguments Re: Claim 19

Claim 19 patentably defines over Thagard, et al. and Kobey since neither Kobey nor Thagard, et al. show a hydraulic cylinder with a piston on a deck which is spaced from a guard. It would not be obvious to add a hydraulic cylinder with a piston to Kobey, which teaches a push lawnmower, not a boom mower, for the reasons set forth in connection with claim 10.

Further, claim 19 is patentable over Kobey and Thagard for the reasons discussed above for claim 68. Kobey teaches the use of a lift up guard to expose the entire front wall of the housing, and parts of the two adjacent side walls, as shown in Figure 1 thereof. Similarly, Thagard shows a design in Figs. 2 and 3 exposing the entire front wall, if not also adjacent side walls (Fig. 3) of the housing. Neither reference teaches or discloses a guard assembly forming a single corner of a deck, as recited in claim 19.

7. Appellant's Arguments Re: Claim 73

Claim 73 recites the two opposed corners along the front edge of the deck, as shown in Fig. 6 of the present specification. A first corner includes the guard, which is selectively pivotable to a position above a plane of the deck. A second corner, located adjacent the guard assembly, comprises two side walls which are rigid and non-moving. A first side of the deck includes both the first and second corners.

In contrast, Kobey's guard extends along the entire front edge of the mower and includes both corners. Thus, Kobey does not show two opposed corners along one side of a deck where one corner has two side walls which are rigid and non-moving and the other corner has a guard assembly pivotable to a position above the plane of the deck.

Claim 73 was asserted by the Examiner to state, "the guard is positioned in a first corner of the deck" not that the deck (sic) is the first corner. The Examiner contends that the applicant is arguing something that is not claimed. However, the language "said guard is positioned in a first corner of the deck" (emphasis added) means that the guard is located at the first corner of the deck. It does not mean that the deck (or guard) itself is a first corner, as the Examiner suggests. These words are simple and easily understood. Kobey's guard is simply not located at a first corner but extends from one corner to a second corner. Accordingly, claim 73 patentably defines over Kobey and is also in condition for allowance.

8. Appellant's Arguments Re: Claim 72

Claim 72 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobey in view of MoTrim. Kobey was stated to disclose the claimed deck and guard assembly detailed above. However, the mower in Kobey is a push mower instead of a boom mower. Like Kobey, MoTrim was stated to disclose a mower head with a guard used to cut brush. The guard design of MoTrim, which is the prior art design sold by applicant's company, is also shown in Fig. 2A of the instant specification, and is stated to be in the prior art.

Unlike Kobey, the mower deck and guard assembly in MoTrim is attached to a boom. The Examiner concluded that it would have been obvious to one having ordinary skill in the art at the time the invention was made to alternately attach the mower deck and guard assembly of Kobey to a boom, as in MoTrim. The Examiner stated that the applicant seemed to argue that the combination in the rejection was to replace only the guard of the mower deck in MoTrim with the guard in Kobey. That rejection would have been MoTrim in view of Kobey. However, the rejection was Kobey in view of MoTrim. The suggested combination was to attach the entire mower deck and guard assembly in Kobey to a boom. The Examiner asserted that this is different from the combination argued by applicant.

Claim 72 is patentable over Kobey in view of MoTrim, in either interpretation. Claim 72 recites a guard assembly pivotally attached to a deck adjacent a second side edge, opposite a first side edge to which a boom arm is attached. Claim 72 is patentable over Kobey even in view of the MoTrim brochure, because there is no motivation in either MoTrim or Kobey to replace the deck and guard (which includes a guard that extends over the entire front edge of the mower), so modified that it extends over only a section of the deck, as called for in claim 72.

In that regard, Kobey states that the front portion of a mower housing can be hinged to expose the blade in order to enable the blade to sever the stalks of tall plants before the leading edge of the housing reaches same (col. 1, lines 40-44). In contrast, in MoTrim, the leading edge of the housing, namely the inside edge, near the boom, reaches the taller plants meant to be cut before the blade does, since it takes the taller plants to push the swinging guard rearward, above the blade and below the deck, enabling such plants to be cut.

In rejecting claim 72 as being unpatentable over Kobey in view of MoTrim, the Examiner failed to show any motivation, suggestion, or teaching of the desirability for combining the inventions of Kobey and MoTrim. The teachings of Kobey and MoTrim can be combined only if there is some suggestion or incentive in one of the references, or the general state of the art, to do so. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). The Examiner, on the other hand, used impermissible hindsight in combining the push mower of Kobey with the mower

attached to a boom of the MoTrim Mower Brochure. The Examiner is not allowed to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. *Id* F.3d at 1953 and USPQ2d at 1457.

“Obviousness cannot be predicated on what is unknown. *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 339, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).” *Id* F.3d at 1534 and USPQ2d at 1957.

One of ordinary skill in the art would not be motivated to combine the teachings of Kobey with the teachings of MoTrim because, firstly, the mowers of Kobey and MoTrim are different types of mowers, one being a household push mower and one being a commercial grade boom mower. The essence of hindsight is to piece together the disclosures of various prior art references without providing evidence of a suggestion, teaching or motivation to do so. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614.

Still further, there is no suggestion to combine the teachings of Kobey with those of MoTrim because Kobey teaches away from its combination with MoTrim. In other words, the guard designs shown in Kobey and MoTrim are so different that they cannot be combined without destroying the function of one or the other. Kobey teaches the use of a lift up guard to expose the entire front wall of the housing, and parts of the two adjacent side walls, as shown in Figure 1 thereof. In contrast, MoTrim shows a design exposing only one corner of the housing via a retracting guard. One cannot replace a guard which retracts from one corner of a deck with a guard that lifts up from the entire front wall of a deck to arrive at the structure recited in claim 72. Kobey teaches away from the design shown in MoTrim, thereby not providing any motivation to combine the aforementioned teachings. *Tec Air, Inc. v.*

Denso Manufacturing Michigan Inc., 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

As the Federal Circuit observes in *Tec Air*:

"There is no suggestion to combine ... if a reference teaches away from its combination with another source ... 'A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant ... [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.' *In re Gurley* ... (Fed. Cir. 1994)." *Id.* F.3d at 1360 and USPQ2d at 1298.

As further noted in *Tec Air*:

"If when combined, the references 'would produce a seemingly inoperative device,' then they teach away from their combination. *In re Spinnoble*, ... 405 F.2d 578, 587 160 USPQ 237, 244 (CCPA 1969); see also *In re Gordon* ... (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose)." *Id.* F.3d at 1360 USPQ2d at 1298.

As recently noted by the Federal Circuit, references that teach away from the claimed invention cannot serve to create a prima facie case of obviousness. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 USPQ2d 1001 (Fed. Cir. 2001). That is the precise situation with the attempt to combine Kobey with MoTrim.

Lastly, there is simply no teaching or motivation found in Kobey to take the entire guard and deck assembly of Kobey and place it on a boom, as the Examiner suggests. But, if this were done, the resulting structure would not meet the limitations of claim 72 which call for a mower head having a second side edge located opposite a first side edge, a guard positioned adjacent the second side edge and a boom assembly positioned adjacent the first side edge. As a result, the

rejection of claim 72 over the combination of Kobey with MoTrim fails. Claim 72 is patentable over the art of record.

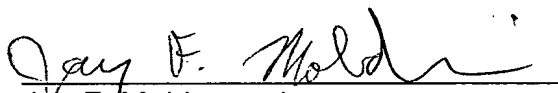
CONCLUSION

In view of the foregoing, Appellant respectfully submits that claims 65, 68 and 73 patentably define over Kobey as well as the rest of the cited art. Claims 10, 17 and 19 patentably define over Thagard, or Kobey in view of Thagard, as well as the remainder of the cited art. Also, claim 72 patentably defines over Kobey in view of MoTrim as well as the remaining cited art.

Accordingly, it is respectfully requested that the Examiner's rejections be reversed.

Respectfully submitted,
FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

Date: 10/14/04


Jay F. Moldovanyi
Reg. No. 29,678
James E. Scarbrough
Reg. No. 47,056
1100 Superior Avenue
Seventh Floor
Cleveland, Ohio 44114-2518
(216) 861-5582



IX. Appendix of Claims (37 C.F.R. §1.192(c(a)))

1-9. (Canceled)

10. (Previously Amended) The mower head of claim 66 wherein said actuating member comprises a hydraulic cylinder and a piston, said cylinder including a chamber surrounding said piston.

11. (Previously Amended) The mower head of claim 65 wherein one of said at least three sides comprises a plurality of angled sections.

12. (Canceled)

13. (Previously Amended) The mower head of claim 65 wherein said deck further comprises a fourth side and at least three side walls, one depending from at least three of said four sides, wherein two of said at least three side walls are rigid.

14-16. (Canceled)

17. (Previously Amended) The mower head of claim 65 wherein one of said at least three sides further comprises an extension which protrudes under said guard.

18. (Canceled)

19. (Previously Amended) The mower head of claim 69 wherein said actuating member comprises a hydraulic cylinder and a piston assembly.

20-38. (Canceled)

39. (Previously Amended) The mower head of claim 67, wherein said flap is a resilient, one-piece flap.

40. (Previously Amended) The mower head of claim 70, wherein said flap is a resilient, one-piece flap.

41-64. (Canceled)

65. (Previously Presented) A mower head comprising:
a deck having at least three sides;
at least one cutting blade rotatably mounted to said deck on an axis extending through said deck, said deck being disposed above and generally parallel to said blade; and
a guard assembly comprising:
a hinge extending between and mounted to two of said at least three sides of said deck at an angle with respect to said two of said at least three sides, and
a guard pivotally attached to said deck via said hinge, wherein a horizontal plane of said guard is parallel to, and spaced from, a horizontal plane of said deck in one orientation of said guard.

66. (Previously Presented) The mower head of claim 65, further comprising an actuating member mounted on said deck.

67. (Previously Presented) The mower head of claim 66, further comprising a flap which depends from said guard.

68. (Currently Amended) A mower head comprising:
a deck comprising:
at least four sides and four corners, and

three side walls, one depending from each of three of said at least four sides, wherein two of said three side walls are rigid;

at least one cutting blade rotatably mounted to said deck on an axis extending through said deck, said deck being disposed above and generally parallel to said blade; and

a guard assembly comprising:

a hinge mounted to and extending at an angle in relation to two adjacent ones of said at least four sides of said deck,

a guard pivotally attached to said deck via said hinge, and

said guard including a plurality of discretely angled sections which angled sections together form a single corner of said deck.

69. (Previously Presented) The mower head of claim 68, further comprising an actuating member mounted on said deck.

70. (Previously Presented) The mower head of claim 68, further comprising a flap which depends from said guard and is movable in relation to said guard

71. (Previously Presented) The mower head of claim 70, wherein said flap is oriented in a plane spaced apart from a plane of said guard.

72. (Previously Presented) A mower head comprising:
a deck having at least four sides including a front side;
a boom arm to which said deck is mounted, said boom arm being positioned adjacent a first side edge of said mower head;

a guard assembly comprising:

a hinge extending at an angle between said front side and an adjacent one of said sides of said deck; and



a guard pivotally attached to said deck via said hinge, said guard being positioned adjacent a second side edge of said mower head, said second side edge being located opposite said first side edge.

73. (Previously Presented) A mower head comprising:

a deck having four sides;

at least one cutting blade rotatably mounted to said deck on an axis extending through said deck, said deck being disposed above and generally parallel to said blade;

a guard assembly comprising a guard pivotally attached to said deck via a hinge which extends between two adjacent ones of said four sides of said deck such that said guard is positioned in a first corner of said deck; and said guard being selectively pivotable to a position above a plane of said deck; and

wherein said deck comprises a second corner, located adjacent said guard assembly, said second corner comprising two side walls which are rigid and non-moving, wherein a first side of said deck includes both said first corner and said second corner.


Certificate of Mailing

Under 37 C.F.R. § 1.8, I certify that this Appellant's Brief (in triplicate) is being

☐ deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP APPEAL BRIEF - PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

☐ transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.
☒ deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP APPEAL BRIEF - PATENTS, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Express Mail Label No.:
EV 494997518 US
Date
October 14, 2004

Signature

Printed Name
Barbara Brazier